

detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects claims 27, 35, 36, 41-43 and 48 as obvious based on the combination of U.S. Patent No. 6,510,453 to Apfel; Harris, "Tuning in to the Internet," Sporting Goods Business, San Francisco, Nov. 1995, Vol. 28, Iss. 11, p. 15; and U.S. Patent No. 5,105,184 to Pirani. After careful review of examiner's latest argument, the Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Please carefully note, the prior art previously cited and referenced, either alone or in combination, does not teach or suggest all the features of the independent claims.

Independent claim 27 recites, among other features, "embedding at least one pre-selected advertisement associated with the identified sending party in said communication, said embedding being done within the data processing system of the

identified sending party; ... **wherein said advertisement is for hardware installed on the data processing system by said identified sending party.** (emphasis added here, and as used hereinafter) Similarly, independent claim 48 recites, among other features, "embedding at least one pre-selected advertisement associated with the identified sending party with the e-mail communication within the data processing system of the identified sending party in said communication; ... **wherein said advertisement is for hardware installed on the data processing system by said identified sending party.**" For the reasons provided below, the Applicant respectfully submits that Apfel, Harris and Pirani, either alone or in combination, do not teach or suggest the above-referenced features of the present invention.

The Official Action relies on Apfel to allegedly teach some of the features of the claimed invention including the transmission of an email from an identified sending party including at least one message associated with the identified sending party in the email. The Official Action concedes that "Apfel does not teach that the embedding is for advertisement, **wherein said advertisement is for hardware installed on the data processing system by said identified sending party**" (page 2, Paper No. 20081118). The Official Action asserts that "Harris teaches an e-mail signature including advertising materials" (pages 2-3, Id.) and asserts that "Pirani teaches advertisement for hardware installed on the data processing system" (page 3, Id.). However, **Pirani does not teach advertisement for hardware installed on the data processing system.** Respectfully, the Applicant disagrees and traverses this assertion in the Official Action.

Initially, it is noted that the primary reference to Apfel appears to be simply directed to an email system that includes signature files. Such technology was generally understood and is disclosed in the specification of the subject application as one method in which the advertisement can be transmitted. That is, the use of signature files in emails was readily known to one of ordinary skill in the art at the time of the present invention. However, the present invention is directed to an improvement in which such known signature file will **automatically include an advertisement for**

**hardware that is attached to the system** initiating the communication. Thus, the teachings of Apfel, while generally and superficially related only to the subject matter of signature files, fails to appreciate the critical features of the presently claimed invention. Glaser makes the advertisement automatically appear because the user added hardware. Apfel did not anticipate this.

Harris admittedly includes an indication that the email signature may include a "one-line marketing tagline describing your product or service." Thus, Harris may disclose an "advertisement" included in an email signature, but, importantly, such disclosure is limited to the "product or service" of the person developing the signature and fails to disclose or suggest that the advertisement will be automatically related to hardware attached to that person's data processing system.

The Official Action asserts that Pirani teaches this feature of the subject invention, namely ***that the advertisement is for hardware installed on the data processing system of the user.*** However, the Applicant respectfully disagrees. Nowhere in Pirani is there a **disclosure that any advertisement should be related to any hardware whatsoever**, let alone hardware that is attached to a data processing system from which a communication is initiated. In fact, the term "hardware" appears in Pirani only in column 2, lines 45 and 52. This portion of Pirani clearly discloses the concept that software development is behind hardware development in conjunction with Pirani's stated advantage that advertisements can be used to facilitate better software development.

Thus, initially, it is respectfully submitted that Pirani clearly fails to disclose or suggest the concept of an advertisement associated with hardware attached to a data processing system and in particular, the advertisement is "automatically" associated with the hardware and "automatically" embedded in any communication of an identified user (and for each thereafter communication), as taught in Glaser. Therefore, for at least this reason, the prior art of record fails to disclose or suggest the features of the claims and the rejections are believed to be overcome for at least this first reason.

The Applicant respectfully submits that Apfel, Harris and Pirani, either alone or in combination, do not teach or suggest automatically embedding at least one pre-selected advertisement associated with an identified sending party in a communication, the embedding being done within a data processing system of the identified sending party, **wherein the advertisement is for hardware installed on the data processing system by the identified sending party.**

Since Apfel, Harris and Pirani do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained.

Furthermore, there is no proper or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Apfel, Harris and Pirani or to combine reference teachings to achieve the claimed invention. MPEP § 2142 states that the examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. It is respectfully submitted that the Official Action has failed to carry this burden. While the Official Action relies on various teachings of the cited prior art to disclose aspects of the claimed invention and asserts that these aspects could be modified in the manner asserted in the Official Action, it is submitted that the Official Action does not adequately set forth why one of skill in the art would combine the references to achieve the features of the present invention.

The test for obviousness is not whether the references "could have been" combined or modified as asserted in the Official Action, but rather whether the references **should have been**. As noted in MPEP § 2143.01, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art" (emphasis in original). KSR International Co. v. Teleflex Inc., 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007). Thus, it is respectfully submitted that the standard set forth in the Official Action is insufficient to support a finding of *prima facie* obviousness.

The Official Action asserts that it would have been obvious to one of ordinary skill in the art at the time of the present invention to combine the teachings of Pirani with those of Harris and Apfel "in order to increase the availability of the particular software or hardware, as taught in Pirani (see col. 2 lines 53-60)" (page 3, Paper No. 20081118). In this regard, it is noted that Pirani has recognized a need to better compensate software developers in that additional revenue from advertisements included in software products are provided to the developers thus providing a further incentive to develop software. Pirani claims it will increase availability of development funding, it does not claim it wants to directly compensate users. These two concepts are not comparable. As noted above, however, such disclosure in Pirani is not related in any way to hardware attached to the data processing system. Furthermore, Pirani is completely silent as to any communication initiated from the data processing system, including a communication that may include such advertisement. Rather, Pirani includes advertisements that may be displayed to a user of the software at that data processing system and no other, during the ordinary course of operation of a unique instance of software by that user. Pirani only displays advertisements during operation of that one instance of software, at that user's data processing system. Pirani does not disclose that one user, causing advertisements to appear for that user, would result in advertisements appearing for any other user, much less at the other end of a communication. There is insufficient motivation for one of ordinary skill in the art at the time of the present invention to have looked to the teachings of Pirani and combined the teachings of Harris, which are related to a signature file that may be manually preset to include information about a sender's products or services. More specifically, the teachings of Harris fail to disclose any problem with respect to software development costs. Pirani lacks the communications and "user's hardware" features of Glaser. Harris lacks automation of advertising with respect to the "user's hardware" feature of Glaser. There is no logical nexus that would cause one of ordinary skill in the art to recognize that Harris should be modified in such a way to include an advertisement to

facilitate increasing software development funds. Furthermore, there is no indication in any of Apfel, Harris or Pirani that the inclusion of an advertisement would, in fact, achieve the objectives asserted in the Official Action, namely increasing revenue to a software developer and, more particularly, since the actual development of software does not involve any significant communication by email or otherwise, software developers would not be motivated to look to such communications to increase their revenue stream. In context, Pirani's use of the term "software developer" was intended to mean a company, not an individual unique developer. Glaser claims to the identification of the unique user. Even if we unreasonably apply a definition that Pirani did mean individual unique software developers when it used the term "software developer", Pirani was not seeking to increase their individual revenue through attached hardware. Pirani does not reference each unique individual software developer, however, arguendo, even if it had, Pirani fails to provide identification means to know which unique software developer, in terms of being a unique individual, it would provide revenue to. Therefore, these asserted motivations in the Official Action are believed to be unreasonable and is not cogently related to the teachings of the primary Pirani and Harris references. For at least this further reason, the rejections of claims 27, 35, 36, 41-43 and 48 are believed to be overcome.

Therefore, the Applicant respectfully submits that the Official Action has not provided a reasonable or sufficient reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Apfel, Harris and Pirani or to combine reference teachings to achieve the claimed invention.

In the present application, it is respectfully submitted that the prior art of record, either alone or in combination, does not expressly or impliedly suggest the claimed invention and the Official Action has not presented a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

For the reasons stated above, the Official Action has not formed a *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Official Action next rejects dependent claims 28, 31-34, 38-40 and 44-46 as obvious based on the combination of Apfel, Harris, Pirani and U.S. Patent No. 5,513,254 to Markowitz. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

Please incorporate the arguments set forth above with respect to the deficiencies in Apfel, Harris and Pirani to the continued arguments below.

Markowitz does not cure the deficiencies in Apfel, Harris and Pirani when combining all to anticipate Glaser. The Official Action **concedes that Apfel, Harris and Pirani do not teach "offering to a user an option of becoming an advertiser"** and asserts that "if the offer is accepted the user being compensated for it, it is taught in [Markowitz] (see col. 2 lines 1-11, col. 4 lines 22-36, and col. 5 lines 4-23)" (page 3, Paper No. 20081118). **Markowitz does not teach this at any of the cited locations or in whole.** The Official next asserts that "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to provide option for the user to include advertisements of products or service for compensation, as in [Markowitz], in order to be compensated" (*Id.*). Furthermore, with specific reference to claims 31-33 and 40, the Official Action concedes that Apfel, Harris and Pirani do not teach "the advertisement is automatically sent for a pre-selected time period and a pre-selected number of times" and asserts that "it is taught in [Markowitz]" (page 4, *Id.*). **Markowitz does not teach this at the cited location or in whole.** The Applicant respectfully disagrees and traverses these assertions in the Official Action. The Applicant carefully checked these cited references and even using his most broad interpretation of the terms of art, Markowitz in no manner, reads to the named Glaser claims. It simply was not there at all.

Claims 33 and 40 recite that the claimed advertisement is electronically attained from a third-party data processing system. Although the Official Action rejects these claims and specifically comments with respect to them at the top of page 4 of the Official Action, there is no reference given whatsoever, anticipating these feature of these claims. Therefore, these claims are believed to be in condition for allowance in that the Official Action fails to address at least this feature of the invention. To the extent that these claims are not allowed, it is believed a new non-final Official Action is in order and respectfully requested.

Furthermore, it is respectfully submitted that Markowitz is directed to a method and apparatus for processing facsimile transmissions and is limited to a system in which an advertisement is included in a facsimile transmission from a fax machine to another fax machine. The user's of Markowitz, according to the claims and disclosure, can be any unidentified user. There is no system, claim or means to identify the user other than what a user puts in their fax, which is printed at the opposite end or displayed on a display. This does not identify the user. Markowitz is silent as to any communication by email, and it is respectfully submitted that one of ordinary skill in the art at the time of the present invention would not have appreciated from the teaching of Markowitz that an advertisement in email should be limited to a specific time period or that it should be electronically obtained from a third party data processing system. In this regard, it is noted that Markowitz is specifically concerned with an issue wherein advertisements across a telephone connection can be included in facsimile communications in addition to voice calls, and the problem addressed in Markowitz is wholly unrelated to any problem found in Pirani, Harris or Apfel. Accordingly, one of ordinary skill in the art at the time of the present invention would not have been motivated to apply the teachings of Markowitz to those of Apfel, Harris and Pirani in order to achieve the present invention, and any such hypothetical combination would not, in fact, result in each and every feature of the present invention that is currently claimed.



With respect to claim 39, the Official Action relies on Markowitz to allegedly “teach fraud avoidance means for reducing or eliminating fraud” (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

While Markowitz (which is limited to a facsimile transmission system) may make reference to random selection of advertisements to avoid an algorithm by which the ultimate intended destination automatically removes the advertisement, such disclosure is not reasonably sufficient to disclose means for avoiding fraud. There is no logical nexus to connect “automatic stripping of advertisements before they arrive” as equaling an attempted “fraud” or any aspect of “fraud”, as the term of art is understood by those of skill. There is no reference to “fraud” in Markowitz and the mere disclosure of random selection of advertisements to avoid removal, is not sufficient to disclose the claimed feature of “fraud avoidance means.” Applicant respectfully asserts “fraud” means, at a minimum, an intent to violate law, misrepresent, mislead with the embedded ad and that those of skill at the time understood this to be the correct interpretation of the term “fraud” as relates to all these references and to Glaser. Therefore, for at least this reason, dependent claim 39 is believed to be separately patentable and allowable.

With respect to dependent claim 46, the Official Action asserts that “Harris teaches embedding a personal testimonial by the sending party” (Id.). The Applicant respectfully disagrees and traverses the assertions in the Official Action.

Harris is limited to disclosing that email signature files could include a description of the products and services of the sending party. Harris does not in any way make reference to a personal testimonial, and a mere reference to the products and services provided by the person in an email signature is not a “personal testimonial” with respect to hardware attached to a data processing system. Harris has not suggested or disclosed that the addition of hardware will cause modification of the signature file, which could then be argued to include a personal testimonial. Therefore, the prior art

fails to disclose the features of claim 46, and claim 46 is believed to be independently patentable and allowable for at least this further reason.

Still further, Markowitz does not explain why one of ordinary skill in the art at the time of the present invention would have had a reason to combine Apfel, Harris and Pirani to achieve the features of the present invention.

Since Apfel, Harris, Pirani and Markowitz do not teach or suggest all the claim limitations and since there is insufficient reason to combine Apfel, Harris and Pirani, or Apfel, Harris, Pirani and Markowitz, a *prima facie* case of obviousness cannot be maintained. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) are in order and respectfully requested.

The Examiner's attention is drawn to Page 11 of the specification of the subject application. At page 11, second paragraph, there is sufficient discussion of the distinguishing features of the present invention over Apfel. The specification discusses placement of advertisement and testimonial in places other than signature files and otherwise, anywhere else desired. Thus the present invention is not limited to the placement of advertisement is in signature files, and it explains how they could be embedded in other ways. Therein, Apfel, Apfel and Harris, or Apfel, Harris and Pirani, alone or in combination, do not teach what is disclosed on Page 11, in the second paragraph and recited in the instant claims. If Apfel was patentable in light of Harris, Apfel being filed in 1999 and Harris being published well before, in 1995, it is more than clear that the claims of the subject application distinguishes well above Apfel much more so, than Apfel distinguished over Harris. This observation, as a test of reasonableness, would suggest that the Glaser claims are more than different enough to be allowed in light of the provided references.

At page 19 of the specification, specifically at paragraph 3, encryption and cryptographic techniques are cited to assure the unique sender and the unique recipient are known, identified and ultimately rewarded, and thus uniquely identified. Nowhere in any of the instant prior art cited, is the sender identified. Apfel, Harris, Pirani and even

Markowitz are silent as to identification of the unique, actual user who sends a communication. As to Pirani, Pirani is silent as to which unique individual software developer is to be funded for further development if we apply an unreasonable interpretation to Pirani's use of the term "software developer" to mean a unique individual. The subject application discloses and claims this feature, identification of the unique sender. How else can the recipient trust that the communication is the unique sender's and not someone using an open fax machine, or open PC? How can fraud avoidance be implemented if you do not know who the sender is? Fraud requires an identified party committing (or attempting) the fraud and equally, an identified party who's embedded ad is, in and of itself, an attempt at fraud or results in fraud. As a matter of law, a "John or Jane Doe" cannot be sued or acted upon for fraud, attempted or real. You must have a unique party to have fraud. Speaking electronically, the same holds true. To avoid fraud, electronically, you have to be able to pin down a unique source. Otherwise, the fraud will occur again and again.

Glaser set forth in the original specification, the problem of an individual touting a product, while those who view the tout, have no proof the user really uses the product or that a testimonial may be true and real. Because of the original specification, read in whole, the identified sender and recipient know of the truth of the identification, and thus they know the identified user's hardware installed, embedded the ads and the ads are safe and checked for no-fraud. These are features of the Glaser system. Apfel never identifies the sender, but it does say the address of the recipient needs to be unique, which is worthy of note because again, it did not do the same for senders. Nothing more is found in Apfel as to unique senders. Harris is even more generic, discussing what was believed to be available then, from current products and service providers, nothing novel and certainly no reference with respect to **identifying who the sender really is** or **automating the embedding of advertisements into communications**, much less, **for a piece of hardware installed on the identified sender's data processing system**. Pirani never identifies the user, the sender or the receiver or

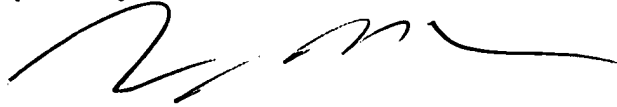
discusses communications at all. Markowitz is for fax machines on dedicated lines and does not distinguish whatsoever as to *who the sender is, who the receiver is* other than an address for a machine at each end or presumably, something written in the text faxed to the opposite end.

Because there must be a reasonable expectation of success when combining all references, to succeed in achieving what Glaser claims, it is believed that all cited references combined, cannot facilitate the claims of Glaser. If the combined references **"cannot provide a reasonable expectation of success"**, this forms yet another reason for the Examiner to consider allowance of the instant claims.

In example, in one primal form of the Glaser invention; a user purchases a computer mouse and attaches it to their computer. Because of the Glaser claims, assuming the mouse includes the Glaser invention, the user having already agreed to advertise said peripheral hardware or in agreeing during this first installation of the mouse, thereafter, advertisements will automatically appear in said user's E-Mail communications for said mouse with all the features of Glaser functioning. It is respectfully submitted the art of Apfel, Harris, Pirani and Markowitz combined, in any order, could not facilitate this simple, initial automatic functionality, allowing a newly attached mouse to advertise itself automatically in that user's communications, nor can these combined references anticipate this function. If there must be a "reasonable expectation of success", not finding this feature operable once all references are combined, demonstrates that there was no success, "reasonable expectation of", or a success in actual outcome.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below to continue proactive discussion and a furtherance of this application toward allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'L. F. Glaser', written over a horizontal line.

---

Lawrence F. Glaser  
Applicant and Inventor  
[shirtbrigade@aol.com](mailto:shirtbrigade@aol.com)  
TMobile 571-235-2435